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EXAMINER

TRAN, PHILIP B

ART UNIT	PAPER NUMBER
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2155

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/626,577	Applicant(s) TOMKOW, TERRANCE A.	
	Examiner Philip B. Tran	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 115-121,230-237 and 286-297 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 115-121,230-237 and 286-297 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 118 and 120 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 118 recites the limitation "the verification signature of" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 120 recites the limitation "the verification digital signatures of" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 115-121, 230-237, 286-287, 289, 292, 294 and 296 are rejected under 35 U.S.C. 102(b) as being anticipated by **Barkan** International Publication No. **WO 98/17042**.

Regarding claim 115, **Barkan** teaches the invention as claimed, including a method of transmitting a message from a sender to a destination address through a server displaced from the destination address [see Abstract], the steps at the server of:

receiving the message from the sender [see Abstract, p.23-24, step (h). p.19, step (b)],

transmitting the message to the destination address [see Abstract, p.12, steps (a, b, c), p.23-24, step (h), p.30, step (d)],

receiving at the server an indication from the destination address that the message has been received at the destination address from the server [see Abstract, p.8, p.19, p.29, step c],

maintaining the message and additionally providing at the server a verification of the message [see p.9, p.31-32], and

transmitting to the sender the message and the verification of the message for storage by the sender [see p.33, 1st paragraph, mail server 3 sends proof of receipt message and encrypted message from recipient (user 2) and stores in mail box 12 belonging to sender (user 1)].

Regarding claim 116, **Barkan** teaches the invention as claimed, the step at the server of: discarding the message and the verification of the message after the transmission of the message and the verification of the message to the sender and before any authentication of the message [see p.35, step 1].

Regarding claim 117, **Barkan** teaches the invention as claimed, including steps at the server of: receiving from the sender a copy of the message and the verification of the message before any authentication of the message but after the transmission of the message to the sender [see p.34, step j], generating digital fingerprints of the message and the verification of the message received from the sender [see p. 23-24, steps j-h, p.31-p.32], comparing the digital fingerprints, and authenticating the message on the basis of the results of the comparison [see p. 23-24, steps j-h, p.31-p.32].

Regarding claim 118, **Barkan** teaches the invention as claimed, including the steps at server of: providing at the server, at the same time an attachment including the identity of the sender and the identity and address of the server and the identity and the destination address of a recipient [see p.23, 30], maintaining the attachment and additionally providing a verification of the attachment (generating a digital signature of the attachment), and transmitting to the sender the attachment and the verification signature of the attachment, at the same time as the transmission of the message, and the verification of the message, to the sender [see p.23, 29-30, 34].

Regarding claim 119, **Barkan** teaches the invention as claimed, including the steps at the server of: receiving an attachment from the destination address [see Abstract, p.8, p.19, p.29, step c], maintaining the attachment and additionally providing a verification of the attachment (providing at the server a digital signature of the

attachment), and transmitting to the sender the attachment and the verification (digital signature) of the attachment for storage by the sender [see p.23, 29-30, 34].

Regarding claim 120, **Barkan** teaches the invention as claimed, including the steps at the server of: receiving from the sender copies of the message and the attachment and the verification digital signatures of the message and the attachment, generating digital fingerprints of the message and the verification (digital signature) of the message and digital fingerprints of the attachment and the verification (digital signature) of the attachment, and comparing the digital fingerprints of the message and the verification (digital signature) of the message and comparing the digital fingerprints of the attachment and the verification (digital signature) of the attachment to authenticate the message and the attachment [see p. 23-24, steps j-h, p.29-30, 31-32, 34].

Regarding claim 121, **Barkan** teaches the invention as claimed, including the steps at the server of: receiving the message and the verification (digital signature) of the message at the server from the sender, and authenticating the message at the server on the basis of the message and the verification (digital signature) received by the server from the sender [see p. 23-24, steps j-h, p.29-30].

Regarding claim 230, **Barkan** teaches the invention as claimed, including a method of authenticating a message provided by a sender and transmitted to a

destination server by a second server displaced from the sender and the destination server, the steps at the second server of: providing an electronic attachment including the identity and address of the sender and the identity and address of the second server and the identity and address of the destination server, and transmitting the electronic attachment from the second server to the sender after the transmission of the message from the second server to the destination server but before any authentication of the message by the second server [see Abstract, p.12, steps (a, b, c), p.23-24, step (h), p.30, step (d), p.33, 1st paragraph, p.34].

Regarding claim 231, **Barkan** teaches the invention as claimed, wherein the electronic attachment transmitted from the second server to the sender includes the address and identity of intermediate stations receiving the electronic attachment in the transmission of the electronic message from the second server to the destination server [see p.44, step e].

Regarding claim 232, **Barkan** teaches the invention as claimed, including the steps at the second server of: providing a verification (digital signature) of the attachment at the second server, and transmitting the verification (digital signature) from the second server to the sender at the time of transmitting the attachment from the second server to the sender [see Abstract, p.12, steps (a, b, c), p.23-24, step (h), p.30, step (d), p.33, 1st paragraph, p.34].

Regarding claim 233, **Barkan** teaches the invention as claimed, including the steps at the second server of: providing a digital signature of the attachment at the second server, and transmitting the digital signature from the second server to the sender at the time of transmitting the attachment from the second server to the sender [see Abstract, p.12, steps (a, b, c), p.23-24, step (h), p.30, step (d), p.33, 1st paragraph, p.34].

Regarding claim 234, **Barkan** teaches the invention as claimed, including the steps at the second server of: receiving the electronic attachment and the verification (digital signature) at the second server from the sender [see Abstract, p.12, steps (a, b, c), p.23-24, step (h), p.30, step (d), p.33, 1st paragraph, p.34], and authenticating the attachment at the second server on the basis of the electronic attachment and the verification (digital signature) received by the second server from the sender [see p.23-24, steps j-h, p.31-p.32].

Regarding claim 235, **Barkan** teaches the invention as claimed, including the steps at the second server of: authenticating the electronic attachment at the second server on the basis of the electronic attachment and the digital signature received by the second server from the sender [see p.23-24, steps j-h, p.31-p.32].

Regarding claim 236, **Barkan** teaches the invention as claimed, including the steps at the second server of: receiving at the second server the attachment and the

verification (digital signature) of the attachment from the sender [see Abstract, p.12, steps (a, b, c), p.23-24, step (h), p.30, step (d), p.33, 1st paragraph, p.34], providing at the second server digital fingerprints of the attachment and the verification (digital signature) of the attachment received at the second server from the sender, and comparing the digital fingerprints at the second server to authenticate the attachment [see p.23-24, steps j-h, p.31-p.32].

Regarding claim 237, **Barkan** teaches the invention as claimed, including the steps at the second server of: receiving the attachment and the digital signature at the second server from the sender [see Abstract, p.12, steps (a, b, c), p.23-24, step (h), p.30, step (d), p.33, 1st paragraph, p.34], providing at the second server digital fingerprints of the attachment and the digital signature received at the second server from the sender, and comparing the digital fingerprints to authenticate the attachment [see p.23-24, steps j-h, p.31-p.32].

Regarding claim 286, **Barkan** teaches the invention as claimed, including the steps at the server of receiving from the sender a copy of the message and the digital signature of the message after the transmission of the message to the destination address but before any authentication of the message [see P. 34, step j], and processing the message and the digital signature of the message to determine the authentication of the message [see p. 23-24, steps j-h, p. 31-p32].

Regarding claim 287, **Barkan** teaches the invention as claimed, including the steps of in the course of transmitting the message from the server to the destination address, providing an exchange of data between the server and the destination address relating to the message [see Abstract, p.12, steps (a, b, c), p.23-24, step (h), p.30, step (d) and p.23-24, step (h). p.19, step (b)], recording at the server at least a portion of the data exchanged between the server and the destination address relating to the message, and transmitting the recorded data to a storage means for subsequent production as proof of delivery of the message to the destination address [see Abstract, p.8, p.19, p.29, step c and p.33, 1st paragraph, mail server 3 sends proof of receipt message and encrypted message from recipient (user 2) and stores in mail box 12 belonging to sender (user 1)].

Regarding claim 289, **Barkan** teaches the invention as claimed, including the exchange of data between the server and the destination address includes the identification of the server and the destination address and the identification of the message and an acknowledgement of the receipt of the message by the destination address [see p. 23, 29-30, 34].

Regarding claim 292, **Barkan** teaches the invention as claimed, including the steps of providing a dialog (communication) between the second server and the destination server during the transmission of the message from the second server to the destination server, through stages between the second server and the destination

server, to establish subsequently that the destination server has received the message, and storing at least a portion of the dialog (communication) between the second server and the destination server for subsequent proof of delivery of the message by the second server to the destination server [see p. 23-24, steps j-h, p.29-30, 31-32, 34].

Regarding claim 294, **Barkan** teaches the invention as claimed, including the dialog (communication) between the second server and the destination server is included in the electronic attachment [see Abstract, p. 23-24, steps j-h, p.29-30, 31-32, 34].

Regarding claim 296, **Barkan** teaches the invention as claimed, including the steps of providing a dialog (communication) between the second server and the destination server during the transmission of the message between the second server and the destination server through stages between the second server and the destination server, and storing at least a portion of the dialog (communication) between the second server and the destination server for subsequent proof of delivery of the message by the second server to the destination server [see p. 23-24, steps j-h, p.29-30, 31-32, 34].

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 288, 290-291, 293, 295 and 297 are rejected under 35 U.S.C. 103 (a) as being unpatentable over **Barkan** International Publication No. **WO 98/17042**, in view of **Zabetian** U.S. Patent No. **6,327,656**.

Regarding claim 288, **Barkan** teaches the invention as claimed above. However, **Barkan** does not explicitly teach the data exchanged between the server and the destination address may be via a selected one of SMTP and ESMTP protocols. **Zabetian** teaches the electronic documents send between clients and servers using conventional protocols such as SMTP, FTP, HTTP, and other network protocol could be used to transmit electronic documents (col. 4 lines 25-55, col. 6 lines 21-37, col. 14 lines 53-66). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teachings of **Barkan and Zabetian** to include the step of using a protocol selected from a group of network conventional protocols because it would have an efficient communications system that has a capability for users to send and attach various kinds of files to electronic mail (including electronic document certification, verification, digital signature).

Regarding claim 290, **Barkan** teaches the invention as claimed above. In addition, **Barkan** further teaches the data exchanged between the server and the destination address is used to establish that the message has been received at the

destination address [see p.33, 1st paragraph, mail server 3 sends proof of receipt message and encrypted message from recipient (user 2) and stores in mail box 12 belonging to sender (user 1)].

Regarding claim 291, **Barkan** teaches the invention as claimed above. In addition, **Barkan** further teaches the authentication is provided as follows: generating at the server a digital fingerprint of the message received by the server from the sender, and a digital fingerprint of the digital signature of the message received at the server, and comparing the digital fingerprints generated at the server, and providing an electronic attachment transmitted between the second server and the destination server, and providing a dialog (communication) between the second server and the destination address relating to the message during the transmission of the message from the second server and to the destination server so as to establish subsequently that the destination server has received the message transmitting the electronic attachment from the second server to the sender [see p. 23-24, steps j-h, p.29-30, 31-32, 34].

However, **Barkan** does not explicitly teach the data exchanged (dialog) between the server and the destination address may be via a selected one of SMTP and ESMTP protocols. **Zabetian** teaches the electronic documents send between clients and servers using conventional protocols such as SMTP, FTP, HTTP, and other network protocol could be used to transmit electronic documents (col. 4 lines 25-55, col. 6 lines 21-37, col. 14 lines 53-66). It would have been obvious to one of ordinary skill in the

Data Processing art at the time of the invention was made to combine the teachings of **Barkan and Zabetian** to include the step of using a protocol selected from a group of network conventional protocols because it would have an efficient communications system that has a capability for users to send and attach various kinds of files to electronic mail (including electronic document certification, verification, digital signature).

Regarding claim 293, **Barkan** teaches the invention as claimed, including the dialog (communication) between the second server and the destination server includes matter relating to the identities of the second server and the destination server and relating to the message [see p.23, 29-30, 34].

Regarding claim 295, **Barkan** teaches the invention as claimed, including the dialog (communication) between the second server and the destination server includes an acknowledgement by the destination server that it has received the message [see Abstract, p.8, p.19, p29, step c and p.33, 1st paragraph].

Regarding claim 297, **Barkan** teaches the invention as claimed above. In addition, **Barkan** further teaches providing a dialog (communication) between the second server and the destination server relating to the message during the transmission of the message between the second server and the destination server, storing at least a portion of the dialog (communication) between the second server and

the destination server for subsequent proof of the delivery of the message by the second server to the destination server, wherein the dialog (communication) between the second server and the destination server includes matter relating to the identities of the second server and the destination server and relating to the message and wherein the dialog between the second server and the destination server is included in the electronic attachment [see p. 23-24, steps j-h, p.29-30, 31-32, 34].

However, **Barkan** does not explicitly teach the data exchanged (dialog) between the second server and the destination server being provided via a selected one of SMTP and ESMTP protocols. **Zabetian** teaches the electronic documents send between clients and servers using conventional protocols such as SMTP, FTP, HTTP, and other network protocol could be used to transmit electronic documents (col. 4 lines 25-55, col. 6 lines 21-37, col. 14 lines 53-66). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teachings of **Barkan and Zabetian** to include the step of using a protocol selected from a group of network conventional protocols because it would have an efficient communications system that has a capability for users to send and attach various kinds of files to electronic mail (including electronic document certification, verification, digital signature).

Response to Arguments

7. Applicant's arguments have been fully considered but they are not persuasive because of the following reasons:

In a reasonable broadest interpretation, **Barkan** teaches the invention as claimed, including a method and system of transmitting a message from a sender to a destination address through a server displaced from the destination address and notification of receiving a message [see Abstract], with the functional steps at the server consisting of receiving the message from the sender [see Abstract, p.23-24, step (h). p.19, step (b)], transmitting the message to the destination address [see Abstract, p.12, steps (a, b, c), p.23-24, step (h), p.30, step (d)], receiving at the server an indication from the destination address that the message has been received at the destination address from the server [see Abstract, p.8, p.19, p.29, step c], providing at the server a digital signature of the message [see p.9, p.31-32], and transmitting to the sender the message and the digital signature of the message for storage by the sender [see p.33, 1st paragraph, mail server 3 sends proof of receipt message and encrypted message from recipient (user 2) and stores in mail box 12 belonging to sender (user 1)].

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant obviously attacks references individually without taking into consideration based on the teaching of combinations of references as shown above. With respect to **Barkan**, applicant seems to argue points the examiner has already construed **Barkan** does not explicitly teach while restricting the arguments on the **Barkan/Zabetian** combined to arguments of no motivation.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. See **In re Nomiya, 184 USPQ 607 (CCPA 1975)**. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. See **In re McLaughlin, 170 USPQ 209 (CCPA 1971)**. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See **In re Bozek, 163 USPQ 545 (CCPA) 1969**. Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. See **In re Bode, 193 USPQ 12 (CCPA 1977)**. In this case, the reason for combining the teachings of **Barkan and Zabetian** to include the step of using a protocol selected from a group of network conventional protocols because it would have an efficient communications system that has a capability for users to send and attach various kinds of files to electronic mail (including electronic document certification, verification, digital signature).

As a result, cited prior art does disclose a system and method as broadly claimed by the applicant. Applicant has still failed to identify specific claimed limitations that would define a clearly patentable distinction over prior arts. Therefore, the examiner

asserts that cited prior art teaches or suggests the subject matter recited in independent claims. Dependent claims are also rejected at least by virtue of dependency on independent claims and by other reasons shown above. Accordingly, claims 115-121, 230-237 and 286-297 are still respectfully rejected.

Other References Cited


8. The following references cited by the examiner but not relied upon are considered pertinent to applicant's disclosure.

- A) Tsuei, U.S. Pat. No. 6,654,779.
- B) Flynn et al, U.S. Pat. No. 6,618,747.
- C) McGrane, U.S. Pat. No. 6,760,760.
- D) Helfman et al, U.S. Pat. No. 6,396,513.
- E) Helfman et al, U.S. Pat. No. 6,021,433.

9. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED (35 U.S.C. § 133). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CAR 1.136(A).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (571) 273-8300. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Philip B. Tran
Primary Examiner
Art Unit 2155
March 30, 2007